

Application Ser. No.: 10/786,483
Filing Date: February 25, 2004
Examiner: Chong, Yong Soo

Remarks

In the Office Action, the Examiner noted that claims 1 to 24 are pending in the application; claims 11-14 are withdrawn from consideration; claims 3, 5-10, 16 and 18-23 are allowed; and that claims 1, 2, 4, 15, 17 and 24 are rejected. By this amendment, claims 3-12, 14-16 and 18-24 have been amended, and claims 1 and 2 have been cancelled without prejudice or disclaimer of the subject matter contained therein. New claims 25-28 have been added. Thus, claims 3 to 28 are pending in the application. No new subject matter has been inserted through these amendments.

All of the amendments are fully supported by the specification. In particular, claim 3 was amended to re-write it in the independent form as it depended upon canceled claim 1. Consequently, claims 4-10 were amended in order to properly depend upon claim 3 instead of claim 1. Similarly, withdrawn claim 11, which recites the use of the combination of the invention, was amended to have the same scope as that of the combination of claim 3. Thus, claims 12 and 14 were amended accordingly. Specifically, claim 12 was amended to include certain of the products which activate dopaminergic transmission in the brain as taught in Tables 1 and 2 of the specification at pages 28 and 29 respectively. A similar amendment was made to claims 15, 16 and 18-24 wherein every reference to canceled claim 1 has been deleted (i.e., claims 15, 16 and 24) and any other redundant subject matter has also been deleted. New claims 25 and 26 have been added to claim the specific combinations containing respectively of quinpirole and C1-APB with the compound as recited in claim 3. Finally, similar pharmaceutical compositions are recited in new claims 27 and 28. As noted, support for new claims 25-28 is found in the Tables 1 and 2 at pages 28 and 20 respectively. The Examiner's rejections are respectfully traversed below.

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Election/Restriction

In making two-way restriction final the Examiner has noted that claims 11-14 have been withdrawn from further consideration which are directed to method of treating Parkinson's disease. However, as noted above, claims 11-14 have been amended. Specifically, claims 11, 12 and 14 have been amended to commensurate in scope with that of claim 3. Therefore, it is respectfully requested that claims 11-14, as amended, be rejoined with claims 3-10 and 15-24 (and new claims 25-28) pursuant to provisions of MPEP 821.04 as we argued in our response of August 10, 2005. In particular, MPEP 821.04 states that:

"However, if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined. Where the application as originally filed discloses the product and the process for making and/or using the product, and only claims directed to the product are presented for examination, when a product claim is found allowable, applicant may present claims directed to the process of making and/or using the patentable product by way of amendment pursuant to 37 CFR 1.121.

(emphasis added)

As noted above, claims 11-14, as amended, are drawn to method of treating Parkinson's disease using the compositions of invention group I, i.e., claims 3-10 and 15-28. Since the Examiner has indicated that claims 3, 5-10, 16 and 18-23 are allowable, it is requested that claims 11-14 also be rejoined.

Allowability of Claims

Applicants note with much appreciation allowability of claims 3, 5-10, 16, 18-23.

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Double Patenting Rejection

Claims 1-24 stand rejected provisionally under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 16, 18-20, 22 and 36 of copending Application No. 10/786,810.

Applicants submit herewith a terminal disclaimer, including the statement that assignee of record, Aventis Pharma S. A., is the owner with 100 percent interest of the instant application as well as the one mentioned above. Thus, withdrawal of rejection as to claims 1-24 is respectfully requested.

Rejection Under 35 U.S.C. § 103(a)

Claims 1, 2, 4, 15, 17 and 24 stand rejected under 35 U.S.C. 103(a) as being obvious over Achard et al. (US2001/0027193 A1) in view of Ishihara et al. (US2002/0177593 A1).

Specifically, Achard et al. teach a CB1 antagonist of the formula (I) for use in the treatment of Parkinson's disease, however, as admitted by the Examiner, Achard et al. fails to disclose a composition with products that activate dopaminergic neurotransmission. The Examiner further states that Ishihara et al. teach that bromocriptine, levodopa, ropinirole, pramipexole, rasagiline and entacapone – products that activate dopaminergic neurotransmission – can be used to treat Parkinson's disease. As a result, the Examiner concludes that it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to combine a CB1 antagonist of formula I taught by Achard et al. with a product that activates dopaminergic neurotransmission taught by Ishihara et al.

However, as noted, claims 1 and 2 have been canceled without prejudice and therefore this rejection as to claims 1 and 2 is considered moot.

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On the other hand, as to claims 4, 15, 17 and 24, it is respectfully submitted that claims 4, 15, 17 and 24, as amended, are patentably distinguishable from Achard et al. in view of Ishihara et al. and therefore withdrawal of this rejection as to claims 1, 2, 4, 15, 17 and 24 is respectfully requested.

More specifically, claims 15 and 20 have been amended to include only the elected species, 1-[bis(4-chlorophenyl)methyl]-3-[(3,5-difluorophenyl)(methylsulfonyl)methylene]azetidine, and a product that activates dopaminergic neurotransmission. In addition, claim 4 has been amended to depend upon allowable claim 3. Similarly, claim 17 depends upon amended claim 15, which is believed to be in allowable condition. Finally, claim 24 has also been amended to recite only the elected species, 1-[bis(4-chlorophenyl)methyl]-3-[(3,5-difluorophenyl)(methylsulfonyl)methylene]azetidine). Thus, it is respectfully submitted that claims 4, 15, 17 and 24 fully satisfy the requirements of 35 U.S.C. 103(a). Accordingly, withdrawal of rejection as to claims 1, 2, 4, 15, 17 and 24 is respectfully requested.

New Claims

As noted, new claims 25 to 28 have been presented to claim some of the combinations and pharmaceutical compositions thereof of the elected species, 1-[bis(4-chlorophenyl)methyl]-3-[(3,5-difluorophenyl)(methylsulfonyl)methylene]-azetidine, with quinpirole and C1-APB. Thus, it is submitted that claims 25 to 28 are also in condition for allowance.

Conclusions

In view of the above Remarks, it is respectfully submitted that claims 3 to 28 are now in condition for allowance and the early issuance of this case is respectfully requested. In the event the Examiner wishes to contact the undersigned regarding any matter, please call (collect if necessary) the telephone number listed below.

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As noted above, Applicants concurrently submit herewith a terminal disclaimer. Applicants request the Commissioner to charge any fees associated with this paper and any other fees that are deemed necessary due to this submission to Deposit Account No. 18-1982 for Aventis Pharmaceuticals Inc. Bridgewater, NJ. Please credit any overpayment to Deposit Account No. 18-1982.

Respectfully submitted,

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Encl. Terminal disclaimer (3 pages)

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